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**PRE-APPEAL BRIEF REQUEST FOR REVIEW**

Docket Number (Optional)

03-380

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on \_\_\_\_\_

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name \_\_\_\_\_

Application Number

09/978,144

Filed

10/15/2001

First Named Inventor

Scott A. Rosenberg

Art Unit

3622

Examiner

Jeffrey D. Carlson

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

☐ applicant/inventor.

/David L. Ciesielski/

☐ assignee of record of the entire interest.

Signature

David L. Ciesielski

See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.  
(Form PTO/SB/96)

Typed or printed name

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October 12, 2009

Registration number if acting under 37 CFR 1.34 \_\_\_\_\_

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required.  
Submit multiple forms if more than one signature is required, see below\*.☐ \*Total of \_\_\_\_\_ forms are submitted.

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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
(Attorney Docket No. 03-380)**

<b>In re the Application of:</b>	)	
	)	
<b>Scott A. Rosenberg et al.</b>	)	<b>Examiner: Jeffrey D. Carlson</b>
	)	
<b>Serial No.: 09/978,144</b>	)	
	)	<b>Art Unit: 3622</b>
<b>Filed: October 15, 2001</b>	)	
	)	<b>Confirmation No.: 4095</b>
<b>For: METHOD AND SYSTEM FOR</b>	)	
<b>DYNAMIC AD PLACEMENT</b>	)	

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**REASONS FOR REVIEW OF THE FINAL REJECTION**

Pursuant to the Pre-Appeal Brief Conference Program, Applicant requests review of the Final Office Action mailed on 11 June 2009 for the above-identified application because the Examiner has clearly erred in rejecting the pending claims of this application. In this paper, Applicant refers to remarks within Applicant's Response after Final (hereinafter "Response after Final") that was submitted to the Patent Office on 7 August 2009.

**1. The claimed invention**

Claims 1-3, 5, 7, 8, 11-15, 17-21, 23, 31, 38, 39, 61-63, 68-75, 78-81, and 84-89 are pending. Of the pending claims, claims 1 and 38 are independent. Independent claim 1 and the claims depending from it are directed to methods of re-evaluating an order of a plurality of ads. Independent claim 38 and the claims depending from it are directed to methods of displaying an ad on a client-side machine.

## 2. Status of the claims

In the Final Office Action, the Examiner rejected claims 1-3, 5, 7, 8, 11-15, 17-21, 23, 38, 61-63, 68-75, 78-81, and 84-89 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent Application Publication No. 2002/0083439 (Eldering) in view of U.S. Patent No. 5,848,397 (Marsh), and (ii) the Examiner rejected claims 31 and 39 under 35 U.S.C. § 103(a) as being unpatentable over Eldering in view of Merriman and U.S. Patent No. 7,017,173 (Armstrong). In the Final Office Action, the Examiner did not recite a publication number for Merriman. Applicant assumes that Merriman is U.S. Patent No. 5,948,061, which was cited by the Examiner to reject claims 31, 39, and 52 in the office action mailed December 19, 2008.

## 3. The Examiner's clear error

Independent claim 1 recites, *inter alia*, "the client determining the respective weight value for each ad that is associated with a respective weight value, wherein the client uses a weight rule contained in the ad control file associated with the ad so as to determine the weight value associated with the ad, and wherein the weight rule of at least one of the ad control files *comprises an equation for calculating a weight value that increases proportionately to time passed.*" Claim 38 recites a similar limitation except that the words "client-side machine" are used instead of the word "client."

In rejecting claims 1 and 38 as being obvious over Eldering and Marsh, the Examiner stated that Eldering does not appear to teach a weighted placement value for an ad derived by a product of a re-determined placement value and the ad's weight value whereby the ad's weight value is based upon the ad control file's weight rule which includes an equation for proportionate weight value that increases as time passes. *See*, Final Office Action, page 4, lines 5-8. Thereafter, the Examiner stated that Marsh teaches that a server can deliver the advertising

content as well as the metadata ("ad control information" such as expiration, maximum user impressions, etc.) needed for the client to determine queue sorting and advertisement placement. The Examiner then stated that one of the aspects deemed important to advertising sorting and display is sorting the queue based on 'time since last seen' (tsls) as well as an (advertised-special) criteria for each ad, namely pre-defined weights such as  $c2=TSLS\_WEIGHT$ . These are used in a typical equation which multiplies terms with coefficients to determine a queue order of ads, and the ads can be displayed in accordance with the queue. See, office action, page 4, lines 10-18.

Applicant's remarks of record explain why Eldering and Marsh do not reasonably lead to *wherein the weight rule of at least one of the ad control files comprises an equation for calculating a weight value that increases proportionately to time passed*. See, Applicant's Response after Final, page 15, second paragraph, to page 16, second paragraph.

Furthermore, with regard to the pre-defined weight (i.e.,  $c2=TSLS\_WEIGHT$ ) identified by the Examiner in the rejection of claims 1 and 38, Marsh teaches that  $c1$ ,  $c2$ ,  $c3$ , and  $c4$  of  $c1=TTE\_WEIGHT$ ,  $c2=TSLS\_WEIGHT$ ,  $c3=TE\_WEIGHT$ , and  $c4=PRE\_WEIGHT$ , respectively, are constants, which are assigned predetermined values. See, Marsh, column 10, lines 31-40. Applicant submits that none of these *constant weights* disclosed by Marsh amount to a *weight value that increases proportionately to time passed*.

Furthermore still, in the advisory action mailed 11 September 2009, the Examiner stated, *inter alia*, that an "equation" can include many terms or even a constant ( $x=1$  is an equation). See, advisory action, page 2, lines 1-2. Although an equation may include many terms or even a constant, the combination of Eldering and Marsh does not disclose or suggest an equation for calculating a weight value that increases proportionately to time passed. Moreover, Applicant

submits that the Examiner's example equation  $X=1$  of a constant does not amount to an equation for calculating a weight value that increases proportionately to time passed.

Since Eldering and Marsh do not disclose or suggest an *equation for calculating a weight value that increases proportionately to time passed*, Applicant submits that Eldering and Marsh do not disclose or suggest the client determining the respective weight value for each ad that is associated with a respective weight value, wherein the client uses a weight rule contained in the ad control file associated with the ad so as to determine the weight value associated with the ad, and *wherein the weight rule of at least one of the ad control files comprises an equation for calculating a weight value that increases proportionately to time passed*, as recited in various ways in claims 1 and 38.

Next, independent claim 1 also recites, *for each of the at least one of the ads associated with a respective weight value*, the client *multiplying the re-evaluated placement value associated with that ad by the weight value* associated with that ad so as to determine a weighted placement value for that ad. Independent claim 38 recites a similar limitation except that the words "client-side machine" are used for each instance the word "client" is recited in this limitation of claim 1. Applicant submits that the Examiner clearly erred by asserting that the combination of Eldering and Marsh disclose these limitations of claims 1 and 38. Applicant's remarks of record explain why Eldering and Marsh do not reasonably lead to these limitations of claims 1 and 38. *See*, Applicant's Response after Final, page 16, third paragraph, to page 16, second paragraph.

#### **4. Conclusion**

For the foregoing reasons, Applicant submits that the Examiner clearly erred in rejecting independent claims 1 and 38. Pursuant to the Pre-Appeal Brief Conference Program, Applicant

submits these reasons for review along with a Notice of Appeal and a Pre-Appeal Brief Request for Review, and Applicant respectfully requests review of the Final Office Action mailed 11 June 2009.

Respectfully submitted,

**McDonnell Boenken  
Hulbert & Berghoff LLP**

Date: 12 October 2009

By: /David L. Ciesielski/  
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